

REMARKS

I. Introduction

Claims 1-10 are pending in this application, of which claims 1 and 10 are independent. Applicants acknowledge, with appreciation, the Examiner's indication that claims 2 and 5 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

II. The Rejection of Claim 10 under 35 U.S.C. §102(e)

In the statement of the rejection, the Examiner asserted that Aybay et al. discloses an apparatus and method for controlling data, address and enable buses within a microprocessor identically corresponding to what is claimed. This rejection is respectfully traversed.

It is well established precedent that the factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of the claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *See EMI Group N. Am., Inc. v. Cypress Semiconductor Corp.*, 268 F.3d 1342, 60 USPQ2d 1423 (Fed. Cir. 2001); *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F. 3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

Applicants submit that Aybay et al. does not disclose a multi-initiator control method including, among other things, the step of determining whether or not receipt of a command fetch request from one of the plurality of devices is stored, as recited in claim 10.

The Examiner specifically asserted that Aybay et al. discloses determining if a request has been received by one of the units 12-20 by referring to column 4, line 20 to column 5, line

18, and Figures 2-3 of Aybay et al. However, the Examiner's assertion does not suggest that Aybay et al. performs determination of whether receipt of a command fetch request from one of the plurality of devices is stored. Moreover, there appears to be no description in the Aybay et al. corresponding to the Examiner's assertion, and the Examiner did not specifically identify where Aybay et al. discloses what the Examiner asserted. Applicants presume that the Examiner's assertion might be obtained from the following sentences (column 4, lines 59-65):

If the RCU 20 has not made a request to the BIU 11, the ASM polls the units 12-19 according to a predetermined sequence. An address indicative of the initiator of the winning request is stored within a latch D1 in the arbitration stage 11b, and also forwarded to the control stage 11c as a pre-grant signal PRE_GNT.

However, the above sentences do not describe any determination, and thus, does not disclose "determining whether or not receipt of a command fetch request from one of the plurality of devices is stored," recited in claim 10.

Accordingly, it is apparent that Aybay et al. does not identically describe the claimed invention within the meaning of 35 U.S.C. §102. Applicants, therefore, submit that the imposed rejection of claim 10 under 35 U.S.C. §102(e) for lack of novelty as evidenced by Aybay et al. is not factually viable and, hence, respectfully solicit withdrawal thereof.

III. The Rejection of Claims 1, 3, 4 and 6-9 under 35 U.S.C. §103(a)

In the statement of the rejection, the Examiner admitted that Applicants' admitted prior art ("AAPA) does not disclose that the control unit is a multi-initiator control unit, and a plurality of command control circuits controls a command processing sequence. The Examiner, then, applied Nagasaka and asserted that the reference teaches the above missing features of the AAPA. As a result, the Examiner concluded that it would have been obvious to modify the

AAPA based on the teachings of Nagasaka to arrive at the claimed invention. This rejection is respectfully traversed.

Applicants submit that the Examiner has not established a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. §103 for lack of the requisite factual basis. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The AAPA and Nagasaka, either individually or in combination, do not disclose or teach a multi-initiator control unit including, among other things, a plurality of command control circuits each for controlling a command processing sequence performed with the corresponding device, as recited in independent claim 1. Each of the plurality of command control circuits corresponds to one of the multiple devices which operate as initiators. Accordingly, the claimed multi-initiator control unit can easily find which device sent the command.

The Examiner specifically asserted that Nagasaka teaches “a target device that can have more than one logical unit, which is a command control circuit, with each logical unit being able to service at least one initiator at a time” by citing paragraphs [0060] to [0064] and Fig. 1 of Nagasaka (the first full paragraph at page 5 of the Office Action). However, there appears to be no evidential support for the Examiner’s assertion. Nagasaka describes as follows (paragraph [0062]):

The target T1 has one logical unit LUN1.... In this embodiment, the target T1 has only one logical unit LUN1, so that the initiators I0 through I3 can gain the log-in only for this logical unit LUN1 of the target T1.

It is apparent that Nagasaka does not teach that there are more than one logical unit, and the Examiner did not provide any reasons why he interpreted that Nagasaka teaches more than one logical unit. Even if it is assumed that Nagasaka teach target T1 having more than one logical

unit, Nagasaka does not teach a multiple initiator control unit including a plurality of logical units, each corresponding to one of multiple initiators, as claimed.

Applicants further submit that there is no motivation to modify the AAPA based on the teachings of Nagasaka to arrive at the claimed invention. In imposing a rejection under 35 U.S.C. §103, the Examiner is required to make a “thorough and searching” factual inquiry and, based upon such a factual inquiry, explain why one having ordinary skill in the art would have been realistically impelled to modify particular prior art, in this case the AAPA, to arrive at the claimed invention. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

The Examiner’s asserted motivation is to allow a target device to be able to receive commands from more than one initiator at the same time (see, the last full paragraph at page 5 of the Office Action). This assertion has not established the requisite motivational element because the Examiner did not provide any substantial evidence to support his assertion. Specifically, neither the AAPA nor Nagasaka teaches allowing a target device to be able to receive commands from more than one initiator at the same time. Applicant stresses that the asserted motivation is developed by heavily relying on hindsight based on the teachings of the present invention. The Examiner is required to provide facts showing that there is motivation to modify the AAPA to arrive at the claimed invention. *In re Lee, supra*.

Based upon the foregoing, Applicants submit that the Examiner has not established a *prima facie* basis to deny patentability to claim 1 for lack of the requisite factual basis and of the requisite realistic motivation. Dependent claims 3, 4 and 6-9 are also patentably distinguishable over the cited references at least because these claims include all the limitations recited in independent claim 1. Applicants, therefore, submit that the imposed rejection of claims 1, 3, 4

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and 6-9 under 35 U.S.C. §103 for obviousness predicated upon the AAPA in view of Nagasaka is not factually or legally viable and, hence, respectfully solicit withdrawal thereof.

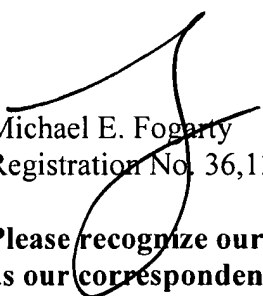
IV. Conclusion

It should, therefore, be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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